

Appl. No. 10/776,851
Atty. Docket No. CM2687MQ
Amdt. dated March 7, 2006
Reply to Office Action of December 7, 2005
Customer No. 27752

REMARKS

Claim Status

Claims 1 - 12 are pending in the present application. No additional claims fee is believed to be due.

Claims 4 and 11 have been amended to change spelling or typographical errors. Support for the amendment to Claim 4 is found at page 9, line 27 of the specification. Support for the amendment to Claim 11 is found at page 9, lines 29-31 of the specification.

These changes do not involve introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Amendments to the Specification

The specification has been amended to correct a missing reference to Figure 8. Support for the change may be found on page 16, lines 21-22 and on page 13, lines 12-13 of the specification. These changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, Second Paragraph

The Office rejects Claims 1-12 "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Specifically, the Office states:

Claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics; thus, expression "a liquefiable substance having a liquefaction temperature from about 40°C. to about 300°C. and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and, in effect, recites compounds by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended. *Ex parte Slob* (Bd. Pat. App. & Int. 1968) 157 USPQ 172; *Austen Laboratories, Incorporated v. Nobilium Processing Company of Chicago et al.*, 115 USPQ 44 (D.C. N. Ill. 1957).

Appl. No. 10/776,851
Atty. Docket No. CM2687MQ
Amdt. dated March 7, 2006
Reply to Office Action of December 7, 2005
Customer No. 27752

Applicant asserts that the Office's reliance on *Slob* is in error. The Board in *Slob* states, "In our opinion, this language purports to cover everything which will perform the desired *functions* regardless of its composition, and, in effect, recites the compounds by what it is desired that they do rather than what they are." *Ex parte Slob*, 157 USPQ 172 (B.P.A.I. 1967)(emphasis added). However, the Court of Customs and Patent Appeals, in a subsequent case, states, "We take the characterization 'functional' . . . to indicate nothing more than the fact that an attempt is being made to define something . . . by what it does rather than by what it is In our view, there is nothing intrinsically wrong with the use of such a technique in drafting patent claims. Indeed we have even recognized in the past the practical necessity for the use of functional language." *In re Swinehart*, 58 C.C.P.A. 1027, 1030 (C.C.P.A. 1971). Functional claiming is clearly permissible as provided in *Swinehart* and its progeny. Applicant asserts that, in light of *Swinehart*, the claims reciting a functional limitation are definite as written.

Rejection Under 35 USC §102

Claims 1-6 and 8-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,425,725 to Tanzer et al. (hereafter "Tanzer"). In support of the rejection, the Office states:

Tanzer *et al.* teach an absorbent core (112, 120) useful for an absorbent article comprising a substrate layer (98) and absorbent material (110), said absorbent material (110) comprising an absorbent polymer material and *optionally* an absorbent fibrous material, said absorbent fibrous material not representing more than about 20 % of the weight of absorbent polymer material, wherein said absorbent material (110) is immobilized (trapped in pocket regions (108)) when wet such that said absorbent core (112, 120) achieves a wet immobilization of more than about 50% according to the Wet Immobilization Test (see figures 6 and 7, below).

Applicant traverses the rejection on grounds that the Office has failed to present evidence or scientific reasoning to establish the reasonableness of the Office's belief that the claimed wet immobilization is an inherent characteristic of Tanzer.

Applicant will begin with a brief overview of the relevant teachings of Tanzer.

Tanzer teaches an absorbent laminate (112) including a first carrier layer (98) and at least

Appl. No. 10/776,851
Atty. Docket No. CM2687MQ
Amdt. dated March 7, 2006
Reply to Office Action of December 7, 2005
Customer No. 27752

a second carrier layer (100). Col. 3, lines 52-54. Tanzer teaches a carrier attaching means (such as an adhesive (102)) that secures together the carrier layers (98, 100) to provide attached zones (104) and unattached zones (106). Col. 3, lines 54-58. The unattached zones (106) provide a plurality of pocket regions (108) which contain a high-absorbency material, such as particles of superabsorbent material (110). Col. 3, lines 58-62.

Tanzer teaches that the carrier attaching means can be a water-sensitive mechanism. Col. 3, lines 65-68. Tanzer states:

[T]he wet-strength of the attachment system is configured to be sufficiently low so as to not excessively constrict the swelling expansion of the high absorbency material during the absorption of liquid. The wet-strength of the attachment system is less than the separating force imparted by the swelling of the high absorbency material when the high absorbency material is exposed to aqueous liquids, such as urine.

Col. 14, lines 43-51. In other words, Applicant asserts that Tanzer's attachment system has a low wet-strength that will separate when the high absorbency material (such as particles of superabsorbent material (110)) swells in the presence of an aqueous liquid and exerts a separating force. In several passages, Tanzer states that the attachment system releases at an applied load which is less than the load needed to burst either carrier layers. See col. 14, lines 57-61; col. 16, lines 29-34; and col. 17, lines 57-62.

With regard to the anticipation rejection based on inherency, the Board of Patent Appeals and Interferences has stated:

We are mindful that there is a line of cases represented by *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971) which indicates that where an examiner has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, the examiner possesses the authority to require an applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Nevertheless, before an applicant can be put to this burdensome task, the examiner must provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art. In the case before us, no such evidence or reasoning has been set forward.

Ex parte Skinner, 2 U.S.P.Q.2D (BNA) 1788 (B.P.A.I. 1986). With regard to Claim 1, Applicant asserts that the Office has failed to provide evidence or scientific reasoning to

Appl. No. 10/776,851
Atty. Docket No. CM2687MQ
Amdt. dated March 7, 2006
Reply to Office Action of December 7, 2005
Customer No. 27752

establish the reasonableness of the Office's belief that Tanzer inherently possess a wet immobilization of greater than 50%. In particular, the Office has failed to consider that Tanzer teaches an attachment system having a low wet-strength that will separate when a high absorbency material swells in the presence of an aqueous liquid and exerts a separating force. Applicant asserts that, upon "substantial release of the wet securement between the carrier layers" (col. 16, lines 29-34), any wet immobilization of Tanzer will be minimal. Upon release of the wet securement between the carrier layers, Applicant asserts that the pocket regions (108) will open and will no longer contain the absorbent material therein. Applicant addresses the deficiencies of Tanzer in the Background of the present application on page 2, lines 9-21. In light of the separation of the layers as disclosed in Tanzer, Applicant asserts that the Office has not provided sufficient evidence or reasoning for the conclusion of inherency.

Furthermore, the Court of Appeals for the Federal Circuit, in regard to the requirements for an anticipation rejection based on inherency, has stated:

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999)(citations omitted). Applicant asserts that Tanzer does not provide sufficient teachings to conclude that the absorbent laminate will necessarily yield the wet immobilization as claimed by the Applicant. Conversely, the teachings of Tanzer (*i.e.*, attachment system having a low wet-strength) suggest that the absorbent laminate will have little to no wet immobilization.

With regard to Claim 3, the Office states, "Tanzer et al. teach that the thermoplastic material (100) is a hot melt adhesive." However, Tanzer teaches that item 100 is the carrier layer. Applicant can find no passage in Tanzer teaching the carrier layer (100) as being a hot melt adhesive.

The Office, in an alternative interpretation, states, "[I]n order for someone to actually determine whether or not a particular absorbent core meets the limitation for the instantly claimed invention requires subjecting such a core to the Wet Immobilization Test, making claim 1 a product-by-process claim." MPEP § 2173.05(p) defines a

Appl. No. 10/776,851
Atty. Docket No. CM2687MQ
Amdt. dated March 7, 2006
Reply to Office Action of December 7, 2005
Customer No. 27752

product-by-process claim as “a product claim that defines the claimed product in terms of the process by which it is made.” The wet immobilization value of the absorbent core is not a process by which the core is made. The product-by-process ground for rejecting this claim is inappropriate.

With regard to the alternate grounds of rejection based on 35 U.S.C. § 103(a), the Office states, “[D]ifferences in test characteristics will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such test characteristic is critical.” Applicant asserts that sufficient evidence exists in the application as to the criticality of wet immobilization. Applicant, within the Background of the present application, has described select existing core structures. Tanzer is specifically discussed on page 2, lines 9-21. The deficiency in Tanzer is the ability to maintain wet immobilization. Given this existing discussion in the application, Applicant asserts that ample evidence exists supporting the criticality of wet immobilization.

The Office also states, “A particular parameter must first be recognized as a results-effective variable, i.e. a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” The Office concludes:

Regarding claims 1-12, the benefits of immobilizing the inner materials of a diaper when soaked with urine would have been known prior to applying a test (e.g., prevention the absorbent materials from bunching up excessively in discrete areas of the diaper causing discomfort to a wearer, or aesthetic considerations), making these values result-effective variables. One of ordinary skill in the art would have recognized that increasing the wet immobilization properties of the absorbent material in a diaper or similar article would increase its resistance to moving around between top and back sheets and would prevent the absorbent from bunching up uncomfortably.

MPEP § 2144.05(II)(B) discusses optimization of result-effective variables. Applicant asserts that appreciation of a variable as being results-effective must be found in the prior art. The Office has failed to provide a teaching in a prior art reference that recognizes wet immobilization. The Office recites that “the benefits of immobilizing the inner materials of a diaper when soaked with urine would have been known prior to applying a test.” However, in establishing a *prima facie* case of obviousness, case law clearly places the

Appl. No. 10/776,851
Atty. Docket No. CM2687MQ
Amdt. dated March 7, 2006
Reply to Office Action of December 7, 2005
Customer No. 27752

“burden of proof on the Patent Office . . . to produce the factual basis for its rejection of an application under sections 102 and 103.” *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967). The Office’s comment that “the benefits of immobilizing . . . would have been known” is conclusory. The Office has provided no basis in the prior art for the conclusion that wet immobilization is appreciated as a results effective variable.

In light of the discussion presented above, Applicant respectfully requests withdrawal of the present rejection under 35 U.S.C. §102(b) or, alternatively, under 35 U.S.C. §103(a).

Rejection Under 35 U.S.C. §103

Claims 7 and 12 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Tanzer. The Office states, “Tanzer et al. do not teach the specific dimensions of the crotch width or the specific basis weight of absorbent material.” The Office concludes that “[m]ere changes in size alone are not sufficient to patentably distinguish an invention over the prior art.” Applicant traverses the rejection.

First, Claims 7 and 12 are dependent from and contain all the limitations of Claim 1. Tanzer fails to teach each and every limitation of Claim 1. Therefore, Claims 7 and 12, which include all the limitations of Claim 1, are patentably distinct over Tanzer.

Second, the Office cites *Gardner v. TEC Systems, Inc.* in support of the rejection. However, Applicant asserts that *Gardner* is inapplicable to the present application. The *Gardner* decision is grounded upon two prerequisites. First, the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device. As argued in relation to Claim 1, the differences between Applicant’s invention and Tanzer are more than a mere recitation of dimension. Second, the device having the claimed relative dimensions would not perform differently than the prior art device. Applicant asserts that any limitation on the crotch width may have an adverse impact on an absorbent article. Less width results in less material that can absorb body exudates. Therefore, changing dimension may result in an article that performs differently than disclosed in Tanzer.

In light of the discussion presented above, Applicant respectfully requests withdrawal of the present rejection under 35 U.S.C. §103(a).

Appl. No. 10/776,851
Atty. Docket No. CM2687MQ
Amdt. dated March 7, 2006
Reply to Office Action of December 7, 2005
Customer No. 27752


Conclusion

This response represents an earnest effort to place the application in proper form and to distinguish the invention as claimed from the cited documents. In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under based on 35 U.S.C. §§ 102(b), 103(a), and 112. Early and favorable action in the case is respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By


Eric T. Addington
Registration No. 52,403
(513) 634-1602

Date: March 7, 2006
Customer No. 27752